IN THE

Supreme Court of the United States

OCTOBER TERM, 1940

No. .....

PAYNE FURNACE AND SUPPLY COMPANY, INC., a corporation,

Petitioner,

vs.

WILLIAMS-WALLACE COMPANY, a corporation,

Respondent.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

I. Opinion of the Court Below.–

The majority opinion of the Court of Appeals is found in Vol. IV. at p. 922. The dissenting opinion of Circuit Judge Mathews is at p. 936. The findings of fact and conclusions of law entered by the District Court are at R. pp. 49-62. The District Court did not write an opinion [R. 48-49].

II. Jurisdiction.–

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the act of February 13, 1925; 28 USCA, Sec. 347(a). The date of the judgment to be reviewed is February 14, 1941 [R. 937].

III. The Disclaimer Statute.–

R.S.U.S. Secs. 4917 and 4922 "are parts of one law having one general purpose, and that purpose is to obviate the inconvenience and hardship of the common law, which made a patent wholly void if any part of the invention was wrongfully claimed by the patentee, and which made such a defect in a patent an effectual bar to a suit brought upon it." (*Ensten v. Simon Ascher & Co.*, 282 U.S. 445, 452.) "The statute is remedial; the intent is to aid the inventor free from wilful default or intention to mislead the public by permitting him to avoid the consequence of inadvertence, accident or mistake through prompt disavowal of the apparent right to exclude others from something improperly included in the words of his grant." (*Idem*, p. 452.)

The disclaimer statute "expressly limits a disclaimer to a rejection of something before claimed as new" (*Union Metallic Cartridge Co. v. U. S. Cartridge Co.*, 112 U.S. 624).

IV. Is the Patentee After Filing Disclaimer Precluded or Estopped From Asserting That the Disclaimed Part Was His Original Invention or Discovery?–

The Court of Appeals for the Sixth Circuit, in *Permutit Co. v. Wadham*, 13 F. 2nd 454, 457, held:–

> "We do not understand that a disclaimer to avoid the supposed anticipating or limiting effect of some other publication is a confession that the patent would be void if the disclaimer were not made. The patentee decides a question of policy; he may think that, although the supposed anticipation can be successfully met and defeated, a disclaimer will not af-

> fect the real value of his patent, and to make it will save trouble and expense and do no harm. We see no reason why he is not at liberty, after the disclaimer as before, to deny the anticipatory effect of the other matter; and it has been so held. Manhattan Co. v. Helios Co., 135 F. 785, 802."

and in *Metropolitan Device Corporation v. Cleveland E. Illuminating Co.*, 36 F. 2nd 477, 479, said:–

> "The view we take is that the matter of disclaimer was within the discretion of the patentee to be reasonably exercised—'a matter of policy'—(Permutit Co. v. Wadham, 13 F. (2d) 454, 457 (C.C.A. 6)) * * *."
>
> *Cf. N. O. Nelson Mfg. Co. v. F. E. Myers & Bro. Co.*, 29 F. 2nd 968, 969 (C.C.A. 6).

The Court of Appeals for the Second Circuit, in *Sachs v. Hartford Electric Supply Co.*, 47 F. 2nd 743, 747, said:–

> "However, we do not see that these limitations were in any sense necessary to escape the prior art. A disclaimer is to abandon some part of the invention of which the patentee is not 'the first and original inventor.' If he has claimed originally too much, so that the claims are invalid under the prior art, the part disclaimed must be clearly separate in the body of the specifications; if he wishes to recast the whole, he must go to a reissue. But there is no objection to his limiting a valid patent as his fears may dictate; that does not make valid what would be invalid without it. It is a timorous retreat from positions which he could have successfully maintained. We can there-

fore disregard all of the disclaimer except so much as was necessary to limit claim fourteen, and so much was valid."

The Court of Appeals herein says [R. 935]:–

"The patentee appears to have been moved by the desire to disclaim any monopoly in his composite pipe save when used for the purpose and assembled in the precise manner fully described in his specifications. We doubt the disclaimer was necessary, for these limitations were already implicit in the spirit of the invention claimed."

Are not these decisions of the Courts of Appeals for the Sixth, Second, and Ninth Circuits in conflict with the *Altoona Theatres* decision, wherein this Court said (294 U.S. 492):–

"With the invalid disclaimer must fall the original claims as they stood before the disclaimer. The disclaimer is a representation, as open as the patent itself, on which the public is entitled to rely, that the original claim is one which the patentee does not, in the language of the statute, 'choose to claim, or hold by virtue of the patent.' Upon the filing of the disclaimers, the original claims were withdrawn from the protection of the patent laws, and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned. To permit the abandoned claim to be revived, with the presumption of validity, because the patentee had made an improper use of the disclaimer, would be an inadmissible abuse of the patent law to the detriment of the public.

"While the precise effect of an invalid disclaimer upon the original claim seems not to have been judicially determined, analogous principles of the

patent law are so well recognized as to leave no doubt what our decision should be. It has long been settled that a claim abandoned or rejected in the patent office with the acquiescence of the applicant cannot be revived in a re-issued patent. Yale Lock Mfg. Co. v. Berkshire Nat. Bank, 135 U.S. 342, 379, 34 L. ed. 168, 183, 10 S. Ct. 884; Dobson v. Lees, 137 U.S. 258, 263-265, 34 L. ed. 652, 654, 655, 11 S. Ct. 71."

The Court of Appeals herein said:–

"We do not understand that the Supreme Court in the Altoona Theatres decision, supra, intended to overrule the many decisions upholding disclaimers of this character." [R. 933.]

If the decision herein upon this question is not contrary to said *Altoona Theatres* decision, then there is a necessity for a further review and an additional decision by this Court. The disclaimer statute does not authorize a patentee to disclaim a material or substantial part of the thing patented, upon his acknowledgment that through inadvertence, accident, or mistake, and without fraudulent or deceptive intention he has claimed more than that of which he was the original or first inventor or discoverer, and to then assert,—against such deliberate act in disclaiming,—that of such disclaimed part he was the original or first inventor or discoverer.

If the Court of Appeals herein has decided this question contrary to this Court's decision in the *Altoona Theatres* case certiorari should be granted under *Rule 38* of this Court, *Par. 5, Subd. (b)*, as a decision of a question of federal law in conflict with the applicable decision of this Court.

That the Court of Appeals herein has relied upon the *Permutit v. Wadham, Metropolitan Device Corp. v. Cleveland E. I. Co., N. O. Nelson Mfg. Co. v. F. E. Myers & Bro. Co.,* and *Sachs v. Hartford Elec. Supply Co.* decisions, is demonstrated by the statements in the majority opinion:– "A disclaimer is not necessarily an admission that the patent would be void in the absence of the disclaimer." (Citing these cases.) "Inventors, it would appear, sometimes resort to the disclaimer statute as a matter of policy or precaution in the hope that they may thus forestall litigation, often with the result that more trouble is stirred up than avoided. Or they may be moved to disclaim because on reflection they fear that the claims are so broadly stated as to include a range of equivalents wider than the spirit of the invention justifies." [R. 931-32.] "We doubt the disclaimer was necessary, for these limitations were already implicit in the spirit of the invention claimed." [R. 935.]

The majority opinion herein finds the disclaimer unnecessary, and finds novel patentable invention in the combination of elements disclosed *in the patent claims as granted,* saying [R. 925]:–

> "The invention disclosed, if invention there be, resides in the combination of known elements—namely, in a composite pipe section comprising an inner core pipe, an external pipe, and insulating material interposed between the two, plus the functional relationship of slidability of the inner pipe providing a construction in which, necessarily, the inner and outer stacks are supported independently of each other when the unit sections are joined together."

A careful reading of such opinion shows that the court does not adjudge any of the so-called restrictions of the disclaimers as importing any patentable novelty into the claims; nor are any of such disclaimers given any effect in adjudging the novelty of the claimed combination.

The male and female fittings forming leak-proof joints were claimed in rejected application claims 3, 4, 5 and 8 [R. 936]. The Court of Appeals herein does not find any patentable novelty therein [R. 925-926]. So far as the leak-proof joints are concerned, the disclaimers simply combine with the combination of the patent claims as granted the old rejected combination claims, 3, 4, 5 and 8 upon the leak-proof joints, and the decision herein is predicated upon a finding of patentable novelty in the patent claims as granted, disregarding the inclusion of such old leak-proof joint combination as immaterial.

V. In Interpreting a Patent Claim as Modified by a Disclaimer, Must the Court Consider the Disclaimed Part as Not the Invention of the Patentee, But a Part of the Prior Knowledge and in the Public Domain?–

The disclaimer statute is predicated upon a patentee claiming in his patent more than that of which he was the original or first inventor or discoverer. If he elects to avail himself of the provisions of this statute, his action in disclaiming "a material or substantial part of the thing patented" must be for the reason that "he was not the original or first inventor or discoverer" of such material or substantial part of the thing so patented. We have been unable to find in any of the decisions of this Court a direct statement supporting or repudiating this proposition, or that the disclaimer statute can apply only to such

an excision. Nevertheless, the lack of such an authoritative determination has caused much of the confusion existent in the lower court decisions attempting to construe and apply this disclaimer statute, and further decision by this Court, so determining and interpreting this disclaimer statute, is highly important and presents an important question of federal law.

VI. The Patent Claims as Granted, and the Modifications and Interpolations Made Therein by the Disclaimers.–

Each of the three patent claims is for a combination of mechanical elements [*R.S.U.S. 4888*].

The distinction between the claims as granted in the patent and the restatement thereof by the disclaimer is made clear by the following comparison:

The Patent Claims.	*The "Disclaimer" Claims.*
CLAIM 1.	CLAIM 1.
A composite pipe construction	Composite sectional pipe for conducting fluids or gases of combustion
comprising	comprising
(a) an outer tube,	(a) an outer tube,
(b) one or more layers of insulating material located around the inside surface of the said tube, and	(b) one or more layers of insulating material located around the inside surface of the said tube,
(c) an inner tube slidably located inside the insulating material.	(c) an inner tube slidably located inside the insulating material,

The Patent Claims.

CLAIM 1.

The "Disclaimer" Claims.

CLAIM 1.

(d) adjacent ends of the inner and outer pipes of each section having male and female ends with the male end of the inner pipe located adjacent the female end of the outer pipe, and with the male end of an inner tube pointing downwardly and adapted to be fitted inside the female end of the adjoining lower section so that any condensates forming inside the said inner pipes are carried over the joint, and with the male end of the outer pipe of a section pointing upwardly and adapted to be located inside the female end of the next higher pipe of another section,

(e) so that a joint is provided which sheds any exterior moisture running downwardly over the outer pipes, and the completed joints between adjacent ends of adjoining sections of the inner and outer pipes are in substantial radial alignment,

The Patent Claims.

CLAIM 1.

The "Disclaimer" Claims.

CLAIM 1.

(f) and each string of connected pipe, outer and inner, is independently supported and maintained in connected relationship,

(g) and the insulating material interposed between the two pipes provides an intermediate filler and has a plurality of air cells running longitudinally therethrough.

CLAIM 2.

A composite pipe construction

comprising

(a) an outer tube,

(b) a layer of insulating material formed into a tube and positioned inside the outer tube with its outside surface in contact with the inner surface of the outer tube, and

(c) an inner tube slidably positioned inside the tube of insulating material with its outer surface in contact with the inner surface of the said tube of insulating material.

CLAIM 2.

Composite sectional pipes for conducting fluids or gases of combustion

comprising

(a) an outer tube,

(b) a layer of insulating material formed into a tube and positioned inside the outer tube with its outside surface in contact with the inner surface of the outer tube,

(c) an inner tube slidably positioned inside the tube of insulating material with its outer surface in contact with the inner surface of the said tube of insulating material,

The Patent Claims.

CLAIM 2.

The "Disclaimer" Claims.

CLAIM 2.

(d) adjacent ends of the inner and outer pipes of each section having male and female ends with the male end of the inner pipe located adjacent the female end of the outer pipe, and with the male end of an inner tube pointing downwardly and adapted to be fitted inside the female end of the adjoining lower section so that any condensates forming inside the said inner pipes are carried over the joint, and with the male end of the outer pipe of a section pointing upwardly and adapted to be located inside the female end of the next higher pipe of another section,

(e) so that a joint is provided which sheds any exterior moisture running downwardly over the outer pipes, and the completed joints between adjacent ends of adjoining sections of the inner and outer pipes are in substantial radial alignment,

The Patent Claims.

CLAIM 2.

The "Disclaimer" Claims.

CLAIM 2.

(f) and each string of connected pipe, outer and inner, is independently supported and maintained in connected relationship,

(g) and the insulating material interposed between the two pipes provides an intermediate filler and has a plurality of air cells running longitudinally therethrough.

CLAIM 3.

A compcsite pipe construction

comprising

(a) an inner core pipe,

(b) an external pipe spaced from the inner pipe, and

(c) insulating material interposed between the two pipes, the said pipes being telescopically arranged with respect to one another.

CLAIM 3.

Composite sectional pipes for conducting fluids or gases of combustion,

comprising

(a) an inner core pipe,

(b) an external pipe spaced from the inner pipe,

(c) insulating material interposed between the two pipes, the said pipes being telescopically arranged with respect to one another,

(d) adjacent ends of the inner and outer pipes of each section having male and female ends with the male end of the inner pipe located adjacent the female

The Patent Claims.
CLAIM 3.

The "Disclaimer" Claims.
CLAIM 3.

end of the outer pipe, and with the male end of an inner tube pointing downwardly and adapted to be fitted inside the female end of the adjoining lower section so that any condensates forming inside the said inner pipes are carried over the joint, and with the male end of the outer pipe of a section pointing upwardly and adapted to be located inside the female end of the next higher pipe of another section,

(e) so that a joint is provided which sheds any exterior moisture running downwardly over the outer pipes, and the completed joints between adjacent ends of adjoining sections of the inner and outer pipes are in substantial radial alignment,

(f) and each string of connected pipe, outer and inner, is independently supported and maintained in connected relationship,

(g) and the insulating material interposed between the two pipes provides an intermediate filler.

The foregoing comparison of the patent claims as granted and the purported disclaimer's re-statement and re-construction of claims makes clear:–

The Patent Claims.—These clearly define as the invention patented a single length of composite pipe construction comprising three elements only,– (a), (b) and (c). They do not in any manner indicate,—much less "particularly point out and distinctly claim,"—that the invention resides in providing sectional composite pipes, nor that the invention includes mechanical means,—much less a specific form and interrelation of mechanical means,—for joining the lengths of pipe or sections together, or that such joining or connecting means are of such form or construction as to provide leak proof joints between the adjoining sections. The majority opinion herein points this out:– "It will be seen that the claims do not advert to the matter of male and female fittings so as to provide leak-proof joints" [R. 924]. There is absolutely nothing in the patent claims which even hints at, much less "particularly point(s) out and distinctly claim(s)", that the patented invention is in any degree whatsoever dependent upon (1) the formation of a leak proof joint between sections of pipe, or (2) that such leak proof joint is made by the provision of male and female fittings, or (3) that the completed joint between adjacent ends of adjoining sections of the inner and outer pipes is in substantial radial alignment, or (4) that by the leak proof joints, so formed by male and female fittings, etc., each string of connected pipe is independently supported or maintained in connected relationship.

The Disclaimer Claims.—These attempt to define another and different and unpatented invention as existing in a combination, the first element of which is sectional

pieces of the composites pipe defined in the patent claims, *and* the second element of which is (d) a particular means for joining the sections together in such manner to, and for the purpose of, producing joints between the sections, which joints (e) shed exterior moisture and are leak proof, *and* in which the completed joints between adjacent ends of adjoining sections are in substantial radial alignment; *also* (f) that thereby each string of connected pipe is independently supported and maintained in connected relationship, and further and independent of the thus claimed combination between the sections and the connecting means, these disclaimer claims specify a particular attribute of a particular form of insulating material not a part of the patent claims, i. e., (g) that the insulating material between the two pipes of the sections shall provide an intermediate filler having a plurality of air cells running longitudinally therethrough.

For the sake of emphasis, as well as clarity, we repeat that the disclaimer claims would embrace the following, *not called for or comprehended by the patent claims*:—

(1) that the composite pipe should be made in a plurality of sections;

(2) that adjacent ends of the inner and outer pipes of each section shall have a particular mechanical element for connecting sections together, to wit: male and female ends, etc.;

(3) that these connecting means shall be such that

(a) a joint is provided between the sections which sheds any exterior moisture, and

(b) that the completed joints are in substantial radial alignment;

(4) that the respective outer and inner tubes of the connected sections shall be independently supported and maintained in connected relationship;

(5) that the insulating material interposed between the two pipes shall be of such form and construction as to provide an intermediate filler having a plurality of air cells running longitudinally therethrough.

The majority opinion of the Court of Appeals states:– "It will be seen that *the claims do not advert to the matter of male and female fittings so as to provide leak-proof joints*" [R. 924]. Each of the patent claims is totally silent as to whether the claimed composite pipe is even jointed. The majority opinion of the Court of Appeals herein points out that there is no antecedent for the male and female fittings to provide leak-proof joints, but relies upon structural characteristics which it finds "implicit in the spirit of the invention claimed" [R. 935], justifying its interpolation into the patent claims as granted of said leak-proof joint structures under a confused and erroneous application of the fourth class of disclaimers referred to in footnote (3) of p. 490 of the *Altoona Theatres* decision in 294 U.S., to wit: *"by limiting the claim to a specific type of the general class to which it was applied"* [R. 933].

The majority opinion herein cites the decision in *Byrne Mfg. Co. v. American Flange Co.*, 87 F. 2nd 783 (C.C.A. 6) as "on all fours with the present case" [R. 934]. Do not the facts of such case bring it within the rule of valid disclaimer "by limiting the claim to a specific type of the general class to which it was applied"? In this *Byrne* case, claim 1 called for a "flange" and for a "support" (see footnote, p. 784 of 87 F. 2nd). Was not the effect

of the disclaimer to limit claim 1 to a particular type of "flange" and to a particular type or construction of "support", both limitations corresponding to the types of "flange" and "support" shown and described in the specification? The decision herein, and the reliance placed upon this *Byrne* decison, exemplifies the necessity for a further decision clarifying what is comprehended by the class of disclaimers referred to. The patent claims herein neither directly nor indirectly refer to any joints. How can the disclaimers herein, therefore, be adjudged to limit the claims to a specific type of the general class of joints, when no joints are called for by the granted claims? This fact is recognized by the majority opinion of the Court of Appeals [R. 934]. Said opinion, however, reads this element into the patent claims as granted by an explanatory or interpretative office of the drawings and specifications, upon which the opinion relies as "not to be ignored" [R. 933]. The rule of interpretation that an element or feature of construction cannot be interpolated into a claim for either the purpose of making out a case of novelty or of infringement was early established in *McCarty v. Lehigh Valley Railroad,* 160 U.S. 110. It is repeated in the *Altoona Publix Theatres* case:–

> "While this statute affords a wide scope for relinquishment by the patentee of part of the patent mistakenly claimed, where the effect is to restrict or curtail the monopoly of the patent, it does not permit the addition of a new element to the combination previously claimed, whereby the patent originally for one combination is transformed into a new and different one for the new combination." (294 U.S. p. 490.)

In determining whether a disclaimer is valid, does this rule apply in interpreting the patent claims as granted; or may the court "narrow the field of the claimed monopoly by introducing structural limitations taken directly from the specifications" [R. 934] into the granted patent claims as an antecedent for the disclaimer?

VII. There Is Confusion and Uncertainty as to What Is Comprehended by the Fourth Class of Disclaimers of Footnote ([3]), p. 490 of the Altoona Theatres Decision (294 U.S.), To Wit: "By Limiting the Claim to a Specific Type of the General Class to Which it Was Applied."

Said footnote refers to three decisions. The first is *Minerals Separation v. Butte & S. Min. Co.,* 250 U.S. 336, 354. In this case the disclaimer was not to a specific type of a general class of ingredients. The disclaimer therein was not of any type of oils.– "From this consideration of the terms of the patent as written, it is apparent that it makes no differentiation whatever, either in the claims or in the specification, among the oils having a preferential affinity for metalliferous matter, * * *." (250 U.S. at 348.) The disclaimer disclaimed from claims 9, 10 and 11 of the patent, "any process of concentrating powdered ores, excepting where the results obtained are the results obtained *by the use of oil in a quantity amounting to a fraction of 1 per cent. on the ore.*" (*Cf.* 250 F., bot. p. 249.) (Emphasis supplied.)

The second case referred to in said footnote is *United Chromium v. International Silver Co.,* 60 F. 2nd 913 (C.C.A. 2). The original patent claims called for a process in which the proportion of certain ingredients was established at the start of the process. By disclaimer,

language was added which merely required that afterwards in the operation of the process the operator continued to maintain the same proportions that the claims had originally stated must be established at the start of the process. This did not present any question of disclaimer of a specific type or of the general class of materials to which the patent claims applied.

The third case referred to in said footnote is *Sieberling v. John E. Thropp's Sons Co.,* 284 F. 746 (C.C.A. 3), in which the Court of Appeals divided respecting whether: "The elements remaining after the disclaimer was filed are not only a new combination, but they are invested with a distinct method of operation not claimed in the old combination." (dissenting opinion of Circuit Judge Davis, 284 F. at p. 759). The disclaimer and the patent claim are set forth at p. 757 of 284 F. The patent claim called for "a power-driven ring core" and "a spinning roll * * * to shape the sheeted fabric on the core * * *." The disclaimer disclaimed any –

> "combination of the recited elements *except when* constructed and co-ordinated for shaping and applying a previously unshaped sheet fabric strip to that part of the recited ring core beyond the tread portion, *and unless* the power drive for the ring core functions by a sufficiently high speed of rotation and consequent centrifugal force to throw the unapplied fabric portion out from the side of the ring core, while the recited spinning roll in its radial movement, and while pressed toward the ring core, functions by a gradual action upon such centrifugally thrown-out fabric to shape it to the side of the rotating ring core while bringing it into adhesive contact therewith."

This Court granted certiorari. When the case came before this Court, the question of disclaimer was not considered because:– "As we have found that there is nothing really new in the method or mechanism of State, it will serve no purpose to go through the qualifying disclaimers in detail and consider their effect." (264 U.S. 330).

The confusion and uncertainty presented by this footnote (3) to the *Altoona Theatres* case decision have caused such a confusion in the minds of the majority of the Court of Appeals herein that the rule of such footnote requires further clarification by this Court. The impossibility of applying the kind or character of disclaimer of any of the three cited decisions to the facts of this case is apparent. The misconception by the Court of Appeals herein of that class of disclaimers referred to, and its inapplicability to the facts of this case, have caused the Court of Appeals herein to decide this case contrary to the *Altoona Theatres* decision and the decisions in the cases cited in said footnote (3).

CONCLUSION.

We respectfully submit, for the reasons stated in the petition, the prayed for relief should be granted and this Court should settle and clarify by another decision these confusing questions applicable to the disclaimer statute.

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